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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,613	11/04/2000	Daniel H. ILLowsky	A-70000/RMA	8521

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EXAMINER

DUONG, FRANK

ART UNIT PAPER NUMBER

2666

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/706,613	<b>Applicant(s)</b> ILLOWSKY, DANIEL H.	
	<b>Examiner</b> Frank Duong	<b>Art Unit</b> 2666	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2000.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/26/01 &amp; 2/6/02</u> | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

1. This Office Action is a response to communication dated 11/04/2000. Claims 1-30 are pending in the application.

#### ***Information Disclosure Statement***

2. The information disclosure statements filed 02/26/01 and 01/29/01 comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. They have been considered and placed in the application file.

#### ***Specification***

3. The disclosure is objected to because of the following informalities:

Applicant is required to amend the specification to include the serial numbers of the copending applications recited on pages 1-2 and thereafter.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 23-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 23 recites the limitation "said single virtual file" in line 3 and "said receiver" in line 5. There is insufficient antecedent basis for these limitations in the claim.

Claim 23 recites "said physical file being by a previously received subfile" in lines 6-7. It is unclear what Applicant intends to claim in the recitation. Perhaps, Applicant should amend to recite --said physical file being receive by a previously received subfile-- to reflect that described in the specification.

Dependent claims 24-25 variously depend from their indefinite parent claim 23.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 30 of copending Application No. 09/706,614. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following rationales.

***Claim 1 of the instant application 09/706,613 calls for.***

A method for streaming electronic content from a sender to a receiver over a communication link, said method comprising the steps of:

forming a single virtual story file comprising substantially the complete electronic content of comprising:

a set of logical files, each logical file including a header indicating that the first logical file procedural/data content offset is 0 and that the last procedural/data element offset is the size of the logical file procedural/data content less one atomic element;

automatically and intelligently reforming the single virtual story file into a plurality of sequentially arrayed subfiles, each subfile including: (i) a header identifying a first subfile offset from a reference location in the single virtual file and containing a substantially complete story for a predetermined playback period or playback functionality; (ii) a currently executable portion with each said subfile that executes when said subfile is opened after receipt; and (iii) a control portion that controls loading and execution of other subfiles;

communicating said single virtual tile over said communication link in a data stream at a data rate commensurate with available bandwidth and characteristics of said communication link, said physical tile being received by said receiver as sequential portions of said single virtual file in the form of individual subfiles; and

the opening of a later received subfile being controlled by a previously received subfile such that each said currently executable portion of each of said subfiles is executed only upon the direction of an earlier executing subfile.

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Claims 2-22 further limit claim 1.

***Claim 30 of the copending application calls for.***

A method for building an information stream for self-directed loading and playback in an information appliance', said method comprising steps of:

*constructing* a single physical or virtual file as a concatenation of a plurality of sub-files, which contain sets of logical tiles; and

constructing each sub-file to include at least one procedural thread having at least one executable instruction and optionally including parameters associated with said instruction.

A skilled artisan would have recognized the claimed invention of claims 1-22 of the instant application obviously encompasses the claimed invention of claim 30 of the copending application 09/706,614. In addition, the subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter. Thus, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 23-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Balabanovic (USP 6,480,191).

Regarding **claim 23**, in accordance with Balabanovic reference entirety, Balabanovic discloses a method for streaming electronic content (col. 9, line 12 and thereafter; multimedia messaging) over a communication link (a network), said method comprising the steps of:

communicating said single virtual file (multimedia chronicle) over said communication link in a data stream at a data rate commensurate with available bandwidth and characteristics of said communication link, said virtual file being received by said receiver as sequential portions of said single physical tile (col. 9, line 54 to col. 10, line 4, Balabanovic discloses user A creates a multimedia chronicle depicted in FIG. 4A and an XML representation of the multimedia chronicle and e-mail it to user B. The recitation of "contents of a multimedia chronicle reside upon a user's personal computer and yet be accessed by others through a web interface" anticipates the claimed limitation in a manner as claimed); and

controlling the opening of a later received subfile portion of said physical file being received by a previously received subfile portion such that a currently executable portion of each of said subfiles is executed upon the direction of an earlier executing subfile (*col. 10, line 5 to col. 11, line 24, Balabanovic lays out numerous options available to user B to view ("controlling the opening") the received multimedia chronicle to include mouse clicking as well as audio gauge. Moreover, Figs. 3a and col. 8, line 15 to col. 9, line 11, Balabanovic shows the structure of the multimedia chronicle to include sub-chronicles*).

Regarding **claim 24**, in addition to features recited in base claim 23 (see rationales discussed above), Balabanovic further discloses forming said single physical file (Fig. 3a; 300); and said single physical file (Fig. 3a; 300) comprising: a plurality of sequentially arrayed logical subfiles (320 and 340); a currently executable portion (322, 326, 330 or 340) within each said logical subfile (320 or 340) that executes when said logical subfile is opened after receipt (*col. 8, lines 33-55*); and a control portion that controls loading and execution of another logical subfile (audio file) (*Fig. 4a; audio gauge 410 or 420*).

Regarding **claim 25**, in addition to features recited in base claim 23 (see rationales discussed above), Balabanovic further discloses forming said single virtual file (Fig. 3a; 300); and said single virtual file comprising: a plurality of sequentially arrayed logical subfiles (Fig. 3a; 320 and 340), each logical subfile (320 or 340) including a header (322, 326, 330 or 342) identifying a first subfile (324, 328, 332 or 346) offset from a reference location (323 or 327) in the single virtual file and containing



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a substantially complete story for a predetermined playback period or playback functionality (*col. 8, lines 33-55*); a currently executable portion (322, 326, 330 or 340) with each said logical subfile (320 or 340) that executes when said logical subfile is opened after receipt(*col. 8, lines 33-55*), and a control portion that controls loading and execution of another logical subfile (audio file) (*Fig. 4a; audio gauge 410 or 420*).

Regarding **claims 26-28**, the claims call for a computer program of claims 23-25. They are rejected by the same rationales discussed above.

Regarding **claim 29**, in accordance with Balabanovic reference entirety, Balabanovic discloses a system for streaming electronic content (multimedia mail) over a communication channel linking at least one sender and at least one receiver (*Figs. 1A-1B and col. 3, line 26 to col. 5, line 8 encompasses the environment in the preamble*), said system comprising:

a file maker within said sender (*Fig. 1b; 150 and 125 or col. 9, lines 55-56; user A*) for constructing a single virtual or physical file (multimedia chronicle) having predefined virtual file attributes (*col. 8, lines 24-27; hyperlink, audio and video clips*) (*user A discloses at col. 9, lines 54-56 composes multimedia chronicle depicted in Fig. 3a using equipment depicted in Fig. 1b*);

a detector within said sender (*Fig. 1b; 124*) detecting at least a bandwidth characteristic of said communication channel (*It is inherent 124 in conjunction with 150 performs the claimed function*);

a transmitter within said sender (*Fig. 1b; 150 and 124*) communicating said single virtual file (multimedia chronicle) over said communication link (internet) in a data

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stream at a data rate commensurate with available bandwidth and characteristics of said communication link, said virtual file being received by said receiver as sequential portions of said single subfiles (*col. 9, line 54 to col. 10, line 4, Balabanovic discloses user A creates a multimedia chronicle depicted in FIG. 4A and an XML representation of the multimedia chronicle and e-mail it to user B. The recitation of "contents of a multimedia chronicle reside upon a user's personal computer and yet be accessed by others through a web interface" anticipates the claimed limitation in a manner as claimed*); and

a controller within said receiver (*col. 10, lines 6; user B*) controlling the opening of a later received subfile portion of said virtual file being by a previously received subfile portion such that a currently executable portion of each of said subfiles is executed upon the direction of an earlier executing subfile (*col. 10, line 5 to col. 11, line 24, Balabanovic lays out numerous options available to user B to view ("controlling the opening") the received multimedia chronicle to include mouse clicking as well as audio gauge. Moreover, Figs. 3a and col. 8, line 15 to col. 9, line 11, Balabanovic shows the structure of the multimedia chronicle to includes sub-chronicles*).

Regarding **claim 30**, in addition to features recited in base claim 29 (see rationales discussed above), Balabanovic further discloses wherein said file maker includes a data structure builder for forming said single physical or virtual file; and said single physical or virtual file comprising: a plurality of sequentially arrayed logical subfiles, each logical subfile including a header identifying a first subfile offset from a reference location in the single physical file and containing a substantially complete

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story for a predetermined playback period or playback functionality; a currently executable portion with each said logical subfile that executes when said logical subfile is opened after receipt; and a control portion that controls loading and execution of another logical subfile (*col. 10, line 5 to col. 11, line 24, Balabanovic lays out numerous options available to user B to view ("controlling the opening") the received multimedia chronicle to include mouse clicking as well as audio gauge. Moreover, Figs. 3a and col. 8, line 15 to col. 9, line 11, Balabanovic shows the structure of the multimedia chronicle to include sub-chronicles*).

#### ***Allowable Subject Matter***

7. Claims 1-22 would be allowed should the Applicant file a terminal disclaimer to overcome the obvious type double patenting rejection.
8. The following is a statement of reasons for the indication of allowable subject matter:  
The prior art of record, considered individually or in combination fails to fairly show or suggest the claimed invention of base claim 1 having novel and unobvious feature of *"forming a single virtual story file comprising substantially the complete electronic content of comprising: a set of logical files, each logical file including a header indicating that the first logical file procedural/data content offset is 0 and that the last procedural/data element offset is the size of the logical file procedural/data content less one atomic element; automatically and intelligently reforming the single virtual story file into a plurality of sequentially arrayed subfiles, each subfile including: (i) a header identifying a first subfile offset from a reference location in the single virtual file and*

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*containing a substantially complete story for a predetermined playback period or playback functionality; (ii) a currently executable portion with each said subfile that executes when said subfile is opened after receipt; and (iii) a control portion that controls loading and execution of other subfiles" structurally and functionally interconnected with other limitations in a manner as recited in claims 1-22.*

### **Conclusion**

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Barrus et al (USP 6,784,899).

Gifford et al (USP 6,549,612).

Miller et al (USP 6,421,707).

Boaz et al (USP 5,333,266).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Duong whose telephone number is (571) 272-3164. The examiner can normally be reached on 7:00AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be reached on (571) 272-3174. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Frank Duong', with a stylized, cursive script.

Frank Duong  
Examiner  
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September 24, 2004